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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/368,378 01/14/95 BOVA

D 94247

VENKAT, J. EXAMINER

15M1/0630

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ART UNIT PAPER NUMBER

1502

DATE MAILED: 06/30/95

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-12 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1-12 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

Receipt is acknowledged of prior art filed on 4/17/95 .

- 1. The following is a quotation of the first paragraph of 35 U.S.C. § 112:
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.**

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to adequately describe the scope of the expression " compound metabolized to nicotinic acid ". The description for the above expression is limited to five compounds at page 4 , lines 12-14 . However the expression also includes other derivatives of nicotinic acid for which there is lack of description .

- 2. Claims 1-9 and 11 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.**
- 3. Claims 5 , 7, and 10-12 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

The following enumerated reasons apply :

- 1. Correction is requested in claim 5 for %. Note that the claim recites both % and parts .**
- 2. The following is suggested in claim 7 at line 1 to read as " binder is polyvinyl pyrrolidone .**
- 3. Structures for the compound of claims 10 and 12 are requested .**

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4. Claim 11 is indefinite as it is dependent on itself .

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. Claims 1-9 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by O'NEILL ET AL , U.S.PATENT NO. 5,268,181.

See col. 1 , lines 46 et seq for nicotinic acid and the method of use , see col. 3-4 and see the examples .

Applicants are requested to update the status of the parent application by proper amendment .

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Venkat whose telephone number is (703)308-2439. The examiner can normally be reached on Monday-Friday from 9:30 a.m.-5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (703)308-2927. The fax phone number for this group is (703)305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703)308-2351.

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J. Venkat
June 29, 1995

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GROUP 1000